

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant: Benjamin David Foster et al.

Title: LISTING RECOMMENDATION IN A NETWORK-BASED COMMERCE SYSTEM

Docket No.: 2043.090US1

Filed: October 20, 2003

Examiner: Adam Levine



Serial No.: 10/689,970

Due Date: December 2, 2007 (Sun.)

Group Art Unit: 3625

**MS Appeal Brief - Patents**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

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X Appellants' Reply Brief Under 37 C.F.R. 41.41 (9 pgs.).

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Peter Ribuffoni



S/N/10/689,970

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. 41.41

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

In response to the Examiner's Answer mailed October 2, 2007, please see the remarks  
below:

## **REMARKS**

### **1. STATUS OF THE CLAIMS**

The present application was filed on October 20, 2003 with claims 1-28. In response to a non-final Office Action mailed June 13, 2006, claims 29 and 30 were added. A Final Office Action (hereinafter "the Final Office Action") was mailed January 25, 2007. Claims 1-30 stand twice rejected, remain pending, and are the subject of the present Appeal.

## **2. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

- 1) Claims 1, 10, 21, 25 and 28 were rejected under 35 U.S.C. § 112, second paragraph, for failing to set forth the subject matter which Appellants regard as their invention.
- 2) Claim 12 was rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.
- 3) Claims 1-2, 4-11, 21 and 23-30 were rejected under 35 U.S.C. § 102(b) for anticipation by Hirooka et al. ("Extending content-based recommendation by order-matching and cross-matching methods") (hereinafter Hirooka).
- 4) Claims 3, 12-20 and 22 were rejected under 35 U.S.C. § 103(a) as being obvious over Hirooka in view of Ryan (U.S. Publication No. 2003/0055831).

### **3. ARGUMENT**

#### ***A. Discussion of the Rejections***

##### **A.1 The rejection of claims 1, 10, 21, 25, and 28 under § 112**

Appellants respectfully submit that the Examiner's Answer of October 2, 2007 incorrectly characterizes Appellants' claimed invention. In particular, the Examiner's Answer states that "[a]ccording to their argument, appellants regard as the invention 'a new, unique, or at least different search query' that is 'based on identified terms occurring within an original, first search query.'" Examiner's Answer at p. 8, § A. The Examiner's Answer goes on to state that "[i]t is noted that this language does not appear in the claims." *Id.* The Examiner's Answer is correct in this statement, the quoted language does not appear in Appellants' claims; however, the Examiner is apparently misconstruing Appellants argument contained in Section C.1 of Appellants' Appeal Brief of July 2, 2007.

To further clarify, the Final Office Action of January 25, 2007 asserts that "the invention is different from what is defined in the claim(s) because claims 1, 10, 21, 25, and 28 do not include any distinct reference to a new, unique, or at least different search query created based on identified terms occurring within an original, first search query." Final Office Action at p. 8, § 1. This was quoted in Appellants' Appeal Brief. Appeal Brief of July 2, 2007 at § C.1. Later, in the same section of the Appeal Brief, Appellants used the Examiner's assertion to particularly point out the "new, unique, or at least different search query" as distinguished from the "original, first search query" as represented in Appellants claims. Appellants were merely using the Examiner's exact language in an attempt to demonstrate to the Examiner that the elements the Examiner asserted were missing in these claims, did in fact exist. Appellants were not attempting to specifically characterize or describe the scope or content of the claimed language using the Examiner's quoted language.

Appellants respectfully maintain the position stated in the Appeal Brief of July 2, 2007, in particular, that the claims as presently recited do, in fact, include proper definiteness to conform with § 112.

##### **A.2 The rejection of claim 12 under § 112**

Appellants respectfully submit that due to an editorial error, Section C.2 of the Appeal Brief filed July 2, 2007 incorrectly stated Appellants' position. Appellants respectfully request the Examiner and the Board of Appeals refer to the Pre-Appeal Brief, on which the Appeal Brief was based, which correctly states Appellant's position and is recited in full below.

Appellants respectfully submit that claim 12, as currently recited, conforms to the requirements of § 112, second paragraph. Appellants respectfully submit that the claim language as currently recited is to be broadly construed and encompass at least the variations described by the Final Office Action. Accordingly, Appellants respectfully request reversal of this rejection of this claim. *Pre-Appeal Brief filed 25 April 2007, § C.2.*

**A.3 The Rejection of claims 1, 2, 4-11, 21, and 23-30 under § 102(b) using Hirooka**

Appellants respectfully maintain that a *prima facie* case of anticipation of claims 1, 2, 4-11, 21, and 23-30 has not been established because Hirooka fails to disclose all elements as arranged in the presently recited claims.

**Concerning claims 1, 21, 25, and 28**

Appellants respectfully maintain the position stated in the Appeal Brief of July 2, 2007. The Examiner's Answer asserts:

The reference discusses the customer using different keywords to search in different categories. These are search queries containing terms. The searching is an interaction. The isolated keywords are identified terms. The keyword vector is a recommendation query and the results are the recommended listing. See Hirooka, section 3.

Examiner's Answer at p. 9-10. However, the cited portions of Hirooka merely state:

In the case of a customer who has an interest in several categories, it is easy to imagine that he or she uses different keywords to search in different book categories. Thus, when we generate a customer profile, which represents the customer's interests, we must generate several sets of keywords for each category that the customer has interests.

Hirooka at § 3.3.1. Hirooka then goes on to state how generating a customer profile is performed:

In TwinFinder, we generate a vector of keywords from titles, authors, synopses, and sub-categories of books purchased. Fig. 3.3 shows the process to generate vectors of keywords for a customer profile. First, the system generates a vector of keywords for each book purchased by a customer. Then, it generates vectors of keywords for the customer profile by summing up vectors of keywords in each category to which books purchased belong.

Hirooka at § 3.3.2. It is immediately clear that Hirooka's "vector of keywords" is not generated using search terms or search queries. Instead, Hirooka merely describes using "titles, authors, synopses, and sub-categories of *books purchased*." Hirooka at § 3.3.2 (emphasis added). There is a clear difference between Hirooka's operation and the Appellants' claimed invention; thus, no *prima facie* case of anticipation has been established and Appellants respectfully request reversal of this rejection.

Concerning claim 1

The Examiner's Answer's asserted that:

... it should be noted that the term "search query" does not appear in the application's specification at all, making its first appearance in claim 1. The lack of clarity in the claim is therefore again highlighted, because if it is distinguishable from the prior art then it is unclear exactly what the enabled invention is that appellants are attempting to claim.

Examiner's Answer at p. 10, lines 11-15. However, as the MPEP states, "[i]n establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it." M.P.E.P § 6.08.01(I). Claim 1 currently recites:

... identifying a term associated with a user interaction in the network-based commerce system, the identified term occurring within a search query ...

and *originally-filed* and presently-pending claim 6 recites:

The method of claim 1, wherein the identified term occurs within a predetermined

minimum number of search queries submitted to the network-based commerce system.

Reviewing claims 1 and 6 in combination clearly demonstrate that the “identified term” may be obtained from a “search query” or a “predetermined minimum number of search queries.” Claim 1 is merely incorporating a portion of originally-filed claim 6’s scope and content.

Moreover, Appellants respectfully submit that the recited claim limitation of a “search query” is fully supported by Appellants’ specification. Appellants recited the pertinent limitation in claim 1 for illustration. Other claims include similar limitations and may be analyzed in a similar fashion. The word “term” is described in Appellants’ originally filed application as stated at page 6, ¶ 0009, lines 8-14:

The term “popular search term” may include any criteria, textual, numeric, visual, audible or otherwise, frequently submitted by users searching a network-based commerce system. For the purposes of this specification, the word “term” is synonymous with the word “phrase” and is also intended to include a plurality of words. Thus, “term” or “phrase” can be used to refer to any entry (or entries) a user enters into a search field when requesting a search of the network-based commerce system.

It is clear that the “identified term” of claim 1 may be obtained from a search query. As such, any implied or asserted ambiguities that the Examiner’s Answer proclaims are clearly without foundation.

#### Concerning claim 6

The Examiner’s Answer’s position with regard to claim 6 is similar to that of claims 1, 21, 25, and 28, which Appellants have responded to above. In particular, Appellants respectfully maintain that Hirooka does not disclose or describe “[an] identified term [that] occurs within a predetermined minimum number of search queries submitted to the network-based commerce system,” as presently recited in claim 6. As such, Appellants respectfully request reversal of this rejection.

#### Concerning claim 10

Appellants respectfully maintain previously-presented arguments with respect to claim 10 and respectfully request reversal of this rejection.



Concerning Claims 2, 4, 5, 7-9, 11, 23, 24, 26, and 27

Appellants respectfully maintain previously-presented arguments with respect to these claims and respectfully request reversal of these rejections.

A.4 The Rejection of claims 3, 12-20, and 22 under § 103(a) using Hirooka in view of Ryan

Appellants respectfully maintain previously-presented arguments with respect to these claims and respectfully request reversal of these rejections.

CONCLUSION

Appellants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Appellants' attorney at 612-371-2134 to facilitate prosecution of this application.

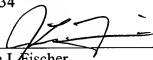
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Respectfully submitted,

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Date 3 Dec 2007

By

  
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Name

Peter Rebuffoni

Signature

